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No. 75-1009

In the
Supreme Court of the United States
October Term, 1975

DUNLOP HOLDINGS LIMITED,
Petitioner,

vs.

RAM GOLF CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the
United States Court of Appeals
for the Seventh Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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TABLE OF CONTENTS

PAGE

ARGUMENT 3

I. The Public Use Of A Patented Article Constitutes A Statutory Bar Against The Issuance Of A Valid Patent Upon An Application Filed More Than One Year After Such Public Use Began, Even Though The Public Use Does Not Inform The Public As To How The Article Was Manufactured 3

II. Petitioner's Suggestion That This Court Should Tailor Its Decision To Improve Its Image Among Patentees And Patent Lawyers Should Be Rejected Out Of Hand 6

CONCLUSION 7

TABLE OF CASES

Egbert v. *Lippmann* (1881), 104 U.S. 33 ..... 2, 3, 4

Electric Battery v. *Shimadzu* (1939), 307 U.S. 5 ..... 2, 4

Gayler v. *Wilder* (1850), 51 U.S. 477 2

Gillman v. *Stern* (2 Cir., 1940), 114 F.2d 28 5

Hall v. *Macneale* (1882), 107 U.S. 90 ..... 2, 4

Kendall v. *Winsor* (1858), 62 U.S. 322 2

Magnetics, Inc. v. *Arnold Engineering Company* (7 Cir., 1971), 438 F.2d 72 5

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This is a routine patent case in which the District Court entered a judgment holding invalid petitioner's patent on Surlyn-covered golf balls because "Butch Wagner made the same invention, which is the subject of Dunlop's patent No. 3,454,280, prior to February 10, 1965, and . . . did not abandon, suppress or conceal it" (14a), and also found that "Butch Wagner's Surlyn-covered golf balls were certainly in public use by late 1964" (19a).

The District Court's judgment was affirmed by the Court of Appeals in an opinion which met head-on petitioner's

argument that Butch Wagner's secrecy regarding the use of Surlyn in his golf ball covers constituted suppression or concealment of his invention—and rejected that contention, holding that "the public use of Wagner's golf balls forecloses a finding of suppression or concealment" (8a).

There is, of course, no question regarding this Court's jurisdiction to consider the petition for writ of certiorari, under the provisions of Title 28, United States Code, §§ 1254(1) and 2101(c).

The petition does not, however, present any question that merits this Court's attention.

Petitioner notwithstanding, neither the District Court nor the Court of Appeals "decided an important question of federal law which has not been, but should be, settled by this court" (Rule 18(b), Supreme Court Rules).

On the contrary, both the District Court and the Court of Appeals simply applied to the facts in this case the plain language of § 102 of the Patent Act—a statutory provision which states conditions for patentability that have been in the law for more than 100 years and have been discussed and applied in numerous decisions of this Court (*e.g., Gayler* v. *Wilder* (1850), 51 U.S. 477, 497; *Kendall* v. *Winsor* (1858), 62 U.S. 322, 328; *Egbert* v. *Lippmann* (1881), 104 U.S. 333, 335-339; *Hall* v. *Macneale* (1882), 107 U.S. 90, 97; *Electric Battery* v. *Shimadzu* (1939), 307 U.S. 5, 20).

In short, the petition for writ of certiorari should be denied because—as we shall now demonstrate—the "Questions Presented" therein have already been decided by this Court, and there is no disagreement regarding their application among the lower federal courts.

ARGUMENT

I. The Public Use Of A Patented Article Constitutes A Statutory Bar Against The Issuance Of A Valid Patent Upon An Application Filed More Than One Year After Such Public Use Began, Even Though The Public Use Does Not Inform The Public As To How The Article Was Manufactured.

The central fallacy in petitioner's "suppression and concealment" argument is that the "invention" claimed in petitioner's patent is not the process by which Du Pont's Surlyn resin is made into a golf ball cover, but a *golf ball* comprising a core and a Surlyn cover.

Thus, Butch Wagner's policy of secrecy regarding the use of Surlyn in his golf ball covers did not constitute suppression or concealment of the patented "invention", for the golf balls themselves—far from being suppressed or concealed—were put into public use, offered for sale, and manufactured and sold on a regular production basis promptly after Wagner had developed a formula which produced commercially acceptable Surlyn-covered balls.

It is, moreover, irrelevant whether the public use and sale of Wagner's golf balls informed the general public that Surlyn was the material from which their covers were made. That is clear not only from the plain language of the applicable statute (34 U.S.C. § 102) but also from this Court's decision in the classic leading case of *Egbert* v. *Lippmann* (1881), 104 U.S. 33.

Thus, § 102(b) of the Patent Act bars the issuance of a patent with respect to any invention that was "in public use or on sale in this country, more than one year prior

to the date of the application for patent" (35 U.S.C. § 102(b)) but does not require that such use or sale teach the public how to make the product which comprises the invention.

And this Court's decision in *Egbert* v. *Lippmann* held that the use of a pair of corset-steels in a corset which was worn in public places by the inventor's lady friend (who later became his wife) constituted a public use of the corset-steels which invalidated the inventor's patent, even though the corset was covered by the lady's outer clothing and, hence, was not in a position where it could be observed by members of the public (104 U.S. 335-339).

That decision provides the conclusive answer to petitioner's argument that certiorari should be granted in this case, for it established the rule that *a public use which does not inform the public is nevertheless a statutory bar* to the issuance of a patent on the product that was publicly used.

A noninforming public use was again held to be a statutory bar in *Hall* v. *Macneale* (1882), 107 U.S. 90. The patent in that case covered an improvement in connecting doors and casings for safes; it was held invalid because of the prior public use and sale of two safes incorporating the patented improvement, even though the components which comprised the improvement were "hidden from view, after the safes were completed, and it required a destruction of the safes to bring them into view"—the Court explicitly stating that "this was no concealment of them or use of them in secret" (107 U.S. 97).

More than 50 years later, in *Electric Battery Co.* v. *Shimadzu* (1939), 307 U.S. 5, the law of public use was

summarized by this Court in the following succinct paragraph:

> "A mere experimental use is not the public use defined by the Act, but a single use for profit, not purposely hidden, is such. The ordinary use of a machine or the practice of a process in a factory in the usual course of producing articles for commercial purposes is a public use" (307 U.S. 20).

That the import of those decisions was fully appreciated by the lower federal courts is readily shown in the following passage from the opinion of Judge Learned Hand in *Gillman* v. *Stern* (2 Cir., 1940), 114 F.2d 28, 31:

> "*We are to distinguish between a public user which does not inform the art* (Hall v. Macneale, 107 U.S. 90, 97, 2 S.Ct. 73, 27 L.Ed. 367) *and a secret user;* some confusion has resulted from the failure to do so. It is true that in each case the fund of common knowledge is not enriched, and that might indeed have been good reason originally for throwing out each as anticipations. But *when the statute made any 'public use' fatal to a patent,* and when thereafter the court held that it was equally fatal, whether or not the patentee had consented to it, *there was no escape from holding*—contrary to the underlying theory of the law—*that it was irrelevant whether the use informed the public* so that they could profit by it" (emphasis supplied).

The continued vitality of the "noninforming public use" rule was, moreover, recognized in the recent opinion of the Court of Appeals for the Seventh Circuit in *Magnetics, Inc.* v. *Arnold Engineering Company* (7 Cir., 1971), 438 F.2d 72, where the patents in suit were held invalid because of public use of the patented machines and methods

more than one year prior to the filing of the applications on which the patents issued, with the Court observing:

> "It is irrelevant whether the use informed the public" (438 F.2d 74).

In this case, the District Court expressly found that "Butch Wagner's Surlyn-covered golf balls were . . . in public use by late 1964" (19a).

In view of that finding, the controlling decisions of this Court (as well as the prior decisions of the lower federal courts which followed them) provided abundant authority for—indeed, required—the Court of Appeals holding that "the public use of Wagner's golf balls forecloses a finding of suppression or concealment" (8a), even though that public use may have been noninforming and, perhaps for a few months, noninformable to the public with the exception of Du Pont.

And petitioner, the Court will note, has not cited a single case which supports the opposite conclusion.

II. Petitioner's Suggestion That This Court Should Tailor Its Decision To Improve Its Image Among Patentees And Patent Lawyers Should Be Rejected Out Of Hand.

Petitioner's argument that the granting of certiorari in this case "would help to bring about the happy thought that this Court is prepared to project a relatively benevolent attitude toward the Patent System" and go far to dispel the fear that the Court is "anti-patent" (Petitioner's Brief, pp. 18-19) is so obviously lacking in merit as to require no counter-argument.

Also untenable is petitioner's suggestion that it is somehow entitled to special consideration from the Court because, by filing its patent application, it set in motion the chain of events which placed the patented invention in the possession of the public.

The fact is that Butch Wagner, by making, using and selling his Surlyn-covered golf balls, had placed the patented invention in the hands of the public more than a year *before* petitioner filed its patent application.

And even though Wagner did not disclose to his customers (or to the general public) the material that was being used in the covers of his golf balls, Surlyn's suitability for such use had become generally known long before petitioner's patent issued.

Indeed, petitioner's patent did not issue until July 8, 1969—some two years *after* respondent began manufacturing Surlyn-covered golf balls on a regular commercial basis.

Petitioner was not, therefore, the source from which the public first learned of the utility of Surlyn as a material for golf ball covers, and is not entitled to any special consideration from this Court merely because it filed a patent application which did not issue until long after the public had learned from other sources of Surlyn's suitability for use in golf ball covers.

CONCLUSION

The petition for writ of certiorari should be denied because it does not present any question which merits this Court's attention.

Respectfully submitted,

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